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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/811,498	03/29/2004	Gerald Duhamel	P1025US01	8902
77130	7590	05/10/2010		
LABTRONIX CONCEPT C/O BENOIT & COTE, s.e.n.c. 1001, DE MAISONNEUVE BOULEVARD WEST SUITE 210 MONTREAL, QC H3A 3C8 CANADA			EXAMINER SAGER, MARK ALAN	
			ART UNIT	PAPER NUMBER
			3714	
			NOTIFICATION DATE	DELIVERY MODE
			05/10/2010	ELECTRONIC

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Notice of the Office communication was sent electronically on above-indicated "Notification Date" to the following e-mail address(es):

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Office Action Summary

Application No.

10/811,498

Applicant(s)

DUHAMEL ET AL.

Examiner

M. Sager

Art Unit

3714

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 03 December 2009.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-19 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-19 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO/SB/226)
- 4) ☐ Interview Summary (PTO-413)
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: _____
- Paper No(s)/Mail Date _____

Claim Interpretation

1. Per MPEP 2111.04, claim scope is not limited by claim language that suggests or makes optional but does not require steps to be performed, or by claim language that does not limit a claim to a particular structure. However, examples of claim language, although not exhaustive, that may raise a question as to the limiting effect of the language in a claim are (A) “adapted to” or “adapted for” clauses, (B) “wherein” clauses, and (C) “whereby” clauses. The determination of whether each of these clauses is a limitation in a claim depends on the specific facts of the case. In *Hoffer v. Microsoft Corp.*, 405 F.3d 1326, 1329, 74 USPQ2d 1481, 1483 (Fed. Cir. 2005), the court held that when a “whereby” clause states a condition that is material to patentability, it cannot be ignored in order to change the substance of the invention.” *Id.* However, the court noted (quoting *Minton v. Nat’l Ass’n of Securities Dealers, Inc.*, 336 F.3d 1373, 1381, 67 USPQ2d 1614, 1620 (Fed. Cir. 2003)) that a “whereby clause in a method claim is not given weight when it simply expresses the intended result of a process step positively recited.”” *Id.*
2. Per MPEP 2114, while features of an apparatus may be recited either structurally or functionally, claims directed to an apparatus must be distinguished from the prior art in terms of structure rather than function. In *re Schreiber*, 128 F.3d 1473, 1477-78, 44 USPQ2d 1429, 1431-32 (Fed. Cir. 1997) (The absence of a disclosure in a prior art reference relating to function did not defeat the Board’s finding of anticipation of claimed apparatus because the limitations at issue were found to be inherent in the prior art reference); see also *In re Swinehart*, 439 F.2d 210, 212-13, 169 USPQ 226, 228-29 (CCPA 1971); *In re Danly*, 263 F.2d 844, 847, 120 USPQ 528, 531 (CCPA 1959). “[A]pparatus claims cover what a device *is*, not what a device *does*.”

Hewlett-Packard Co. v. Bausch & Lomb Inc., 909 F.2d 1464, 1469, 15 USPQ2d 1525, 1528 (Fed. Cir. 1990) (emphasis in original). In this case, the ‘wherein’ clauses fails to state a condition material to its patentability as provided in further evidence below.

Claim Rejections - 35 USC § 101

3. Claim 19 is rejected under 35 U.S.C. 101 because the claimed invention is directed to non-statutory subject matter. The present claims regard a program on a computer readable medium or memory that per OG Notice dated Jan. 26, 2010, the broadest reasonable interpretation in this case covers forms of non-transitory tangible media and transitory propagating signals per se in view of ordinary and customary meaning of computer readable medium or memory, particularly when the instant specification is silent. See MPEP 2111.01.

Claim Rejections - 35 USC § 112

4. Claims 2-4 and 15-17 are rejected under 35 U.S.C. 112, first paragraph, because the specification, while being enabling for operating a meter displayed as at least three different statuses, does not reasonably provide enablement for a meter to gather occurrences of a predetermined symbol and an event independent of a game outcome, gather occurrences of a predetermined combination of symbols and an event independent of a game outcome, gather occurrences of an event dependent of a game outcome and an event independent of a game outcome as presently claimed in claims 2-4 and 16, and Markush grouping with inclusive ‘and’ in claims 15-17 rather than exclusive ‘or’ of Para 10 regarding features triggered [of note: additional combinations are further included by ‘at least one of... and an event independent of a game outcome’ language; however, for brevity only a summation of some of the combinations are stated] since the specification (Para 29) teaches a meter gathers occurrences of an event that

is exclusive of other event rather than inclusive regarding multiple events as presently claimed and disclosure as originally filed states use of multiple meters to track multiple events (Para 30) but claim is one meter tracking multiple different events where there is no teaching for multiple events being gathered by a single meter and there is no evidence in the record of inherency regarding a meter gathering occurrences of multiple different [incongruent or non-related] events and, likewise, regarding features triggered is disclosed as exclusive of each other rather than inclusive (Para 10), as claimed. The meter as a symbol evolves upon occurrence of reaching or exceeding a threshold value of occurrences, but that is not an indication of teaching a meter that inclusively gathers occurrences of multiple different events as claimed since the evolution upon reaching or exceeding a threshold value as taught (Para. 32-33) is gathering occurrences for a single event rather than multiple events claimed. The specification does not enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make/use the invention commensurate in scope with these claims. The scope of present claims as would be interpreted by an artisan require a meter to track multiple events but specification teaches a meter tracks a single event and provides multiple status indication based on those gathering occurrences of that event. The disclosure teaches multiple meters to track multiple different events (Para 30) but it does not teach or suggest a single meter tracking multiple different events so as to display statuses of each of multiple events on a single meter. Claim 2 4 and 16 requires multiple events to be gathered but do not simultaneously claim multiple meters to perform separate accumulation of separate events; while, 15-17 requires multiple features to be triggered and thus includes a form not disclosed to show Applicant possessed the invention as claimed.

Likewise, claims 2-4 and 15-17 further claim Markush grouping with inclusionary term 'and' rather than exclusionary term 'or' that likewise is not taught and not shown in record as being inherent for multiple events.

5. Claims 2-4 and 15-17 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention. The specification, as originally filed, fails to adequately convey to an artisan that the inventor at the time of filing of application, possessed the invention as presently claimed regarding operating a meter displayed as at least three different statuses of an evolving symbol wherein the meter is used to gather occurrences of a predetermined symbol and an event independent of a game outcome, gather occurrences of a predetermined combination of symbols and an event independent of a game outcome, gather occurrences of an event dependent of a game outcome and an event independent of a game outcome that thereby requires a single meter to gather occurrences of multiple different events and trigger features in form that is inclusive as claimed rather than exclusive as disclosed (*supra*). Likewise, claims 2-4 and 15-17 further claim Markush grouping with inclusionary rather than exclusionary language that likewise is not taught and not shown in record as being inherent for multiple events/features.

6. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

7. Claims 2-4 and 15-17 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which

applicant regards as the invention. It is unclear as to how a meter simultaneously displays multiple statuses as claimed where claimed invention claims *in part* a Markush grouping with an inclusive 'and' that thereby requires a meter [i.e. singular] to gather occurrences of dependent and independent game outcomes while disclosure (Para 28) teaches exclusive gathering of occurrences and thus is it unclear as to whether meter regards multiple meters or a single meter that gathers occurrences of multiple events and likewise where features triggered requires multiple features to be triggered due to inclusive term 'and' rather than exclusive 'or'.

Claim Rejections - 35 USC § 102

8. Claims 1, 5-14 and 18-19 are rejected under 35 U.S.C. 102(b) as being anticipated by Bennett (6056642). Where disclosed/claimed evolving symbol includes a color changing symbol per paragraph 27, Bennett discloses a method of operating a game being provided on a gaming machine, a gaming apparatus and a computer program embodied on a computer readable medium or memory having codes adapted to when executed by a computer cause computer to perform the claimed functions (abstract, 2:27-3:2, figs 1-3) including displaying on the gaming machine a line game comprising symbols organized according to a line game structure (abstract, 2:27-3:2, 3:23-38, figs 1-3), operating a meter as at least three different statuses of an evolving symbol that evolves from a clear 7 symbol to colored red, blue or white or any combination thereof and pays an award as jackpot or a portion of jackpot (abstract, 2:27-3:2, 3:27-4:32, figs 1-3) said evolving symbol being part of said symbols organized according to said line game structure (abstract, 2:27-3:2, 3:27-4:32, figs 1-3), triggering a feature on the gaming machine based on at least one of said statuses as jackpot or portion thereof for particular status of evolving symbols (abstract, 2:27-3:2, 3:27-4:32, figs 1-3), where evolving symbols occur on a

reel, each occurrence of evolving symbol comprising an ESU (abstract, 2:27-3:2, 3:27-4:32, figs 1-3), wherein all ESUs evolve upon occurrence of an evolution trigger such as when the three 7s evolve to red, blue or white 7 symbols (abstract, 2:27-3:2, 3:27-4:32, figs 1-3), occurs when the meter reaches a predetermined threshold of three 7 symbols on pay line including only a portion evolve upon occurrence of an evolution trigger where only a portion fails to preclude all (abstract, 2:27-3:2, 3:27-4:32, figs 1-3), wherein the evolution trigger occurs when the meter reaches a predetermined threshold of three 7 symbols on pay line (supra), wherein the number of evolving ESUs is randomly selected per displayed game outcome (supra), wherein the ESUs evolve at same rate such that upon occurrence of three 7 symbols on pay line each symbol evolves to either red, blue or white at same time (as best understood there is no delay between respective reels), wherein each evolving ESU evolves independently such that each 7 symbol on pay line evolves independently (as best understood there is no dependence between displayed symbols on reels to evolve), where a meter gathers occurrences of a predetermined event as a number of 7s on a pay line, a display controller (abstract, 2:27-3:2, 3:27-4:32, fig 1-3, esp. fig 2-3) displaying a line game comprising symbols organized according to a line game structure (supra) and said meter as at least three different statuses of an evolving symbol part of said symbols organized according to said game structure (abstract, 2:27-3:2, 3:27-4:32, figs 2-3) and an evaluation means (ref 30) triggering a feature in said line game based on at least one of said statuses as a jackpot or portion thereof (supra).

Response to Arguments

9. Applicant's arguments, see remarks page 6, filed Feb 25, 2010, with respect to non-statutory subject matter have been fully considered and are persuasive. The rejection of claims 1-17 has been withdrawn.

10. Applicant's arguments with respect to claims 1-19 have been considered but are moot in view of the new ground(s) of rejection. Of note: Bennett does not teach or suggest multiple events being tracked or multiple different features being triggered as in claims 2-5 and 15-17.

Conclusion

11. The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.

12. Any inquiry concerning this communication or earlier communications from the examiner should be directed to M. Sager whose telephone number is 571-272-4454. The examiner can normally be reached on T-F, 0700-1730 hours.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Peter Vo can be reached on 571-272-4690. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/M. Sager/
Primary Examiner, Art Unit 3714